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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,286

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Kwang-Yun Cho

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EXAMINER

KLINKEL, KORTNEY L

ART UNIT

PAPER NUMBER

1611

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/565,286	<b>Applicant(s)</b> CHO ET AL.	
	<b>Examiner</b> Kortney L. Klinkel	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/24/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claims***

Claims 1-5 are pending in the instant Office action.

### ***Election/Restriction***

Applicant's election without traverse of Group I, claims 1-3 in the reply filed on August 25, 2008 is acknowledged.

Applicant states that they believe that claim 5, as now amended to depend from claim 1, meets the unity of invention requirement and accordingly, the unity of invention should be withdrawn. Applicant alleges that claim 5 now forms a single general inventive concept under PCT Rule 13.1. However, as amended, the common technical feature linking claims 1-3 of group I and claim 5 of group III is a fungicidal composition comprising either formula (I) or (II) and an adjuvant. This element cannot be a special technical feature under PCT Rule 13.2 because the element is shown in the prior art.

In the present case, Kim et al. (US 6552080), as evidenced by the Sigma® (product information sheet for Tween®20, updated May, 2003) teach the agrochemicals of formula (I) and formula (II) (compounds 40 and 64 respectively). Kim also teaches a fungicidal composition comprising these compounds and an adjuvant, namely Tween®20, which is a nonionic surfactant which is a polyoxyethylene derivative of sorbitan monolaurate. It has a calculated molecular weight of 1225 daltons, which assumes 20 ethylene oxide units (Sigma® product information sheet for Tween®20). Tween®20 is a polyoxyethylene alkyl ether and more specifically is a polyoxyethylene-

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based nonionic surfactant which has an aliphatic alcohol, a fatty acid or triacyl glyceride as lipophilic moiety containing at least 8 carbon atoms and a polyoxyethylene as hydrophilic moiety having 3 to 25 oxyethylene repeating units. The fungicidal composition of Kim contains a ratio of agrochemical to adjuvant of 1:1 to 1:2 (column 51, lines 25-45). As a result, no special technical features exist among the different groups because the inventions in Groups I-III fail to make a contribution over the prior art. In conclusion, Groups I-III are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept, and therefore, restriction for examination purposes as indicated is proper.

Because Applicant amended their claims around the original restriction requirement, the requirement is still deemed proper and is therefore made FINAL.

Claims 4 and 5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected subject matter, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 25, 2008.

Acknowledgement is also made of Applicant's election of polyoxyethylene alkyl ether, more specifically a polyoxyethylene-based nonionic surfactant which has an aliphatic alcohol, a fatty acid or triacyl glyceride as lipophilic moiety containing at least 8 carbon atoms and a polyoxyethylene as hydrophilic moiety having 3 to 25 oxyethylene repeating units as the adjuvant. Claims 1-3 read on the elected species.

Accordingly, claims 1-3 have been examined to the extent that they read on a polyoxyethylene alkyl ether, more specifically a polyoxyethylene-based nonionic

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surfactant which has an aliphatic alcohol, a fatty acid or triacyl glyceride as lipophilic moiety containing at least 8 carbon atoms and a polyoxyethylene as hydrophilic moiety having 3 to 25 oxyethylene repeating units.

### ***Information Disclosure Statement***

Acknowledgement is made of applicant's submitting an information disclosure statement on October 24, 2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Applicant has submitted a copy of the International Search Report. Applicant is reminded that the listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been

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considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Foreign Priority***

Acknowledgement is made of applicant's foreign priority claim to Republic of Korea patent application serial number 10-2003-0044486 filed July 2, 2003. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al. (US 6552080, as per applicants' IDS) as evidenced by the Sigma® (product information sheet for Tween®20, updated May, 2003).

Kim teaches the agrochemicals of formula (I) and formula (II) (compounds 40 and 64 respectively). Kim also teaches a fungicidal composition comprising these compounds and an adjuvant, namely Tween®20, which is a nonionic surfactant which is a polyoxyethylene derivative of sorbitan monolaurate. It has a calculated molecular weight of 1225 daltons, which assumes 20 ethylene oxide units (Sigma® product information sheet for Tween®20). Tween®20 is a polyoxyethylene alkyl ether and more specifically is a polyoxyethylene-based nonionic surfactant which has an aliphatic alcohol, a fatty acid or triacyl glyceride as lipophilic moiety containing at least 8 carbon atoms and a polyoxyethylene as hydrophilic moiety having 3 to 25 oxyethylene repeating units. The fungicidal composition of Kim contains a ratio of agrochemical to adjuvant of 1:1 to 1:2 (column 51, lines 25-45). The fungicidal efficacy of a composition comprising the compound of formula (I) and a compound of formula (II) with the Tween®20 adjuvant can be seen in Table 9, please refer to compounds 40 and 64.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (US 6552080, as per applicants' IDS) as evidenced by the Sigma® (product information sheet for Tween®20, updated May, 2003).

Kim teaches the agrochemicals of formula (I) and formula (II) (compounds 40 and 64 respectively). Kim also teaches a fungicidal composition comprising these compounds and an adjuvant, namely Tween®20, which is a nonionic surfactant which is a polyoxyethylene derivative of sorbitan monolaurate. It has a calculated molecular weight of 1225 daltons, which assumes 20 ethylene oxide units (Sigma® product



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information sheet for Tween®20). Tween®20 is a polyoxyethylene alkyl ether and more specifically is a polyoxyethylene-based nonionic surfactant which has an aliphatic alcohol, a fatty acid or triacyl glyceride as lipophilic moiety containing at least 8 carbon atoms and a polyoxyethylene as hydrophilic moiety having 3 to 25 oxyethylene repeating units. The fungicidal composition of Kim contains a ratio of agrochemical to adjuvant of 1:1 to 1:2 (column 51, lines 25-45). The fungicidal efficacy of a composition comprising the compound of formula (I) and a compound of formula (II) with the Tween®20 adjuvant can be seen in Table 9, please refer to compounds 40 and 64.

Kim also teaches that a fungicidal composition can comprise one or more of the compounds of formula (I) (column 15, lines 8-10). These compositions can be in combination with a permeating agent (i.e. an adjuvant) such as nonionic, anionic or cationic interface active agents such as fatty acid sodium salts, polyoxy alkyl esters, alkyl sulfonate esters) inter alia (column 15, lines 31-35).

Kim fails to teach a specific embodiment which further comprises another agrochemical for preventing or treating plant diseases, in addition to the adjuvant and agrochemical of claim 1, as necessitated by claim 3. However, Kim teaches that it is possible to have a composition comprising more than one active compound of formula (I). Kim also teaches several compositions which show fungicidal activity with different compounds of formula (I) with the adjuvant Tween®20. Compounds of Kim's formula (I) are fungicides and accordingly, a composition with more than one compound of formula (I) would have "another agrochemical for preventing or treating plant diseases." As compounds of instant formula (I) and (II) (Kim's compounds 40 and 64) are fungicides

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and are taught from a finite list of possible compounds of formula (I), it would be obvious to one of ordinary skill in the art to combine one of them with one or more of the other compounds, with a reasonable expectation for success. "It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

### ***Conclusion***

Claims 1-3 are rejected. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kortney Klinkel whose telephone number is (571)270-5239. The examiner can normally be reached on Monday-Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached at (571)272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KLK

/Sharmila Gollamudi Landau/

Supervisory Patent Examiner, Art Unit 1611